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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/268,999	03/16/1999	YUICHI ARITA	1075.1112/JD	9272

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EXAMINER

THANGAVELU, KANDASAMY

ART UNIT	PAPER NUMBER
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2123

DATE MAILED: 03/18/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/268,999

Applicant(s)

ARITA, YUICHI

Examiner

Kandasamy Thangavelu

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 February 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attachment-A.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: 9 and 10.Claim(s) rejected: 1-8, 11-28.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

*RUSSELL FREJD*  
RUSSELL FREJD  
PRIMARY EXAMINER

### **ATTACHMENT – A: ADVISORY ACTION**

1. The applicant has argued that the term workability is used to indicate both discrete workability or feasibility (yes or no) and the degree of workability or feasibility. Annotated copies of Figures 11 and 12 were included to indicate that discrete workability is determined at Steps B9 and B29. The applicant's explanation of workability and the method of determining workability are not found in the original specification and are new materials being added now. These materials will not be considered and the examiner respectfully disagrees that a new Office action is required. The examiner maintains the rejections of claims 7 and 11 under 35 USC § 112 First Paragraph and Second Paragraph.

2. The applicant has explained the terms main model, working model, component model and workable component model in the amendment of February 24, 2003. However these explanations are not available in the original specification. One of ordinary skill in the art would interpret main model to be more general than a design model; working component model could include standard parts model as well as non-standard parts model; working model could be any model that is functioning or operating. Additionally working model cannot be interpreted as working means model, since working means model includes tool model and hands model.

While there is no requirement that words in the claim must match those used in the specification, there is no freedom to use words that are subject to wide

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interpretations and make the claims not understandable. MPEP § 2173.06, clearly states that where there is a great deal of confusion and uncertainty as to the proper interpretations of the limitations of a claim, it would not be proper to reject such a claim on the basis of prior art. As stated in *In re Steele*, a rejection under 35 U.S.C 103 should not be based on considerable speculation about the meaning of the terms employed in a claim. So the examiner respectfully disagrees that a new Office action is required. The examiner maintains rejections of Claims 24-28 under 35 USC § 112 First Paragraph and Second Paragraph.

3. The examiner takes the position that the 35 USC § 112 Second Paragraph rejections of claims 24-28 are new grounds for rejection necessitated by their amendment. So the office action was made final. The examiner respectfully disagrees that a new non-final office action is required.

4. In view of the above explanation, the request for reconsideration has been considered but is not persuasive and does not place the application in condition for allowance.

K. Thangavelu  
Art Unit 2123  
March 10, 2003

  
RUSSELL FREJD  
PRIMARY EXAMINER